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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/880,777

06/15/2001

Keira Brooke Bard

05793.3065

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08/15/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3695

MAIL DATE

DELIVERY MODE

08/15/2011

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEIRA BROOKE BARD, JEREMY PAUL CLIFFORD, SCOTT
DALLA VALLE, NATHAN TAD CZYZESWKI, BASKARAN
NADARAJAH, PETER LACKEY, WAYNE THOMAS SANCHEZ, and
BRIAN GEORGE PILKO

Appeal 2009-012218
Application 09/880,777
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Keira Brooke Bard et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 30-36, 47-58, 60-88, 90-116, 119, and 120¹. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).²

THE INVENTION

This invention is systems “for providing starter credit card accounts to high credit risk customers that are monitored during a trial period.” Specification [001].

Claim 30, reproduced below, is illustrative of the subject matter on appeal.

30. A system for providing a starter credit account, comprising:
a credit issuer for providing credit accounts including a starter credit account associated with starter credit account parameters and a standard

¹ In response to a new ground of rejection of claims 1-12, 14-28, 37-40, 42-46, 117, and 118 under 35 U.S.C. § 101 in the Answer, the Appellants filed an amendment on March 19, 2009 canceling these claims. *See* Reply Br. 2. Accordingly, we shall not address these claims in our Decision. Upon return of the application, the Examiner should take appropriate steps pursuant to 37 C.F.R. § 41.33.

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Jun. 3, 2008) and Reply Brief (“Reply Br.,” filed Apr. 2, 2009), and the Examiner’s Answer (“Answer,” mailed Feb. 4, 2009).

credit account associated with standard credit account parameters that are more favorable than the starter credit account parameters, wherein the starter credit account is provided to a trial customer who is not eligible to obtain the standard credit account, the credit issuer comprising:

a monitor process for monitoring the starter credit account to determine whether the trial customer has met predetermined criteria associated with the starter credit account during a trial period and adjusting the starter credit account parameters based on the determination;

a trial period modifying process for modifying the duration of the trial period based on activities associated with the starter credit account;

a first memory for storing credit account information associated with standard credit account customers of the credit issuer; and

a second memory for storing starter credit account information associated with the trial customer,

wherein the credit issuer loads the starter credit account information stored in the second memory into the first memory after the starter credit account parameters associated with the starter credit account have been adjusted based on the determination.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Walker

US 6,018,718

Jan. 25, 2000

Sears Tests Starter Card (Card Fax News Brief Vol. 1997, n. 21), Jan.1997, at 1[Hereinafter “Sears”].

The Examiner took official notice that “it is old and well known in the credit card business world that if the credit card holder puts his account in poor standing, the credit card account of such a holder would be downgraded or even suspended (i.e., reduced credit limit, higher interest rate etc.)” Answer 39. *See also* Answer 9. [Hereinafter “Official Notice”].

The following rejection is before us for review:

1. Claims 30-36, 47-58, 60-88, 90-116, 119, and 120 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sears, Walker, and Official Notice.

ISSUE

The issue is whether claims 30-36, 47-58, 60-88, 90-116, 119, and 120 are unpatentable under 35 U.S.C. § 103(a) over Sears, Walker, and Official Notice.

ANALYSIS

Claims 30-36

As discussed below, we find that claims 30-36 are indefinite under 35 U.S.C. § 112, second paragraph. Therefore, we reverse the rejection of claims 30-36 under 35 U.S.C. § 103(a) over Sears, Walker, and Official Notice *pro forma*. The prior art rejections must fall, *pro forma*, because they necessarily are based on speculative assumption as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejections

Claims 47-76, 107-111, and 119

As discussed below, we find that claims 47-76, 107-111, and 119 are directed to nonstatutory subject matter and that this finding is dispositive of the patentability of these claims. Accordingly, we do not reach the prior art rejection of claims 47-76, 107-111, and 119 under 35 U.S.C. § 103(a). *See Diamond v. Diehr*, 450 U.S. 175, 188 (1981); *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (declining to reach an obviousness rejection on appeal after concluding many claims were non-statutory under § 101); *In re Bilski*, 545 F.3d 943, 951 n.1 (noting that § 101 is a threshold requirement and that the Examiner may reject claims solely on that basis); *In re Rice*, 132 F.2d 140, 141 (CCPA 1942) (finding it unnecessary to reach rejection based on prior art after concluding claims were directed to nonstatutory subject matter); *Ex Parte Gutta*, 93 USPQ2d 1025, 1036 (BPAI 2009) (per curiam) (expanded panel) (precedential) (as the claims on appeal do not recite patent-eligible subject matter under § 101, the prior art rejections need not be considered).

Claims 77-106, 112-116, and 120

Independent claims 77, 86, 95, 104, 106, and 112 are all directed to a system and recite only limitations written in means-plus-function format. In rejecting these claims, the Examiner does not specifically address the means-plus-function limitations and instead broadly relies upon their rationale in rejecting various method steps of now canceled method claims and article claims. *See Answer 27-31.*

A claim limitation that includes the term “means” is presumed to be intended to invoke means-plus-function treatment, i.e., treatment under 35 U.S.C. § 112, 6th paragraph. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999). 35 U.S.C. § 112, sixth paragraph “merely sets a limit on how broadly the PTO may construe means-plus-function language under the rubric of ‘reasonable interpretation.’” *In re Donaldson Co.*, 16 F.3d 1189, 1194 (Fed. Cir. 1994).

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed. Cir. 2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed. Cir. 2002). . . . The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

We find that the Examiner does not provide a mean-plus-function analysis to determine the corresponding structure or equivalents from the Specification or point to where the corresponding structure or an equivalent

would be taught in the references. For example, claim 77 recites a “means for monitoring the customer’s activities.” We find that claims 86, 95, 104, 106, and 112 recite similar limitations. While the Examiner asserts, when addressing now-canceled method claim 1, that Sears’s page 1 inherently teaches a similar step (Answer 6), the Examiner provides no reasoning or evidentiary findings as to whether Sears’s page 1 inherently or implicitly teaches the corresponding structure or an equivalent. Given that the Examiner has not performed any means-plus-function analysis, we find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting independent claims 77, 86, 95, 104, 106, and 112. Accordingly, we reverse the rejection of claims 77-106, 112-116, and 120 under 35 U.S.C. § 103(a) as being unpatentable over Sears, Walker, and Official Notice.

NEW GROUNDS OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection on claims 30-36 under 35 U.S.C. § 112, second paragraph, and a new ground of rejection on claims 47-76, 107-111, and 119 under 35 U.S.C. §101.

Claims 30-36 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention under 35 U.S.C. § 112, second paragraph. We find that the scope of the “credit issuer” limitation is insolubly ambiguous as we cannot determine that, when given the broadest reasonable interpretation in light of the Specification, whether a “credit issuer” would encompass a merchant or other business entity that issues credit or would be construed as being restricted to some form of programmed processing device.

Initially, we note that the Specification itself seems to be unclear as to whether credit card issuer element 1200 is a processing device or a merchant or other business entity. Paragraph [038] of the Specification states: “Credit card issuer 1200 may include one or more of the following: a bank, an acquiring bank, a merchant bank, a merchant or any commercial institution capable of providing a credit card consistent with the features disclosed herein.” The Specification also includes statements which suggest that the credit card issuer 1200 is an entity; for example, the Specification states: “Thus, in the event credit card issuer 1200 wishes to solicit customers telephonically” (Specification [035]). However, Figure 2 depicts the credit card issuer 1200 having various processes (*also see for example*, Specification [066]) and the Specification includes a disclosure that the various processes may be implemented in suitable hardware, software, and/or firmware (*see* Specification [031]).

Additionally, we note that if “credit card issuer” was construed as some form of programmed processing device, it would cause claim 30 to be inconsistent with the Specification, which describes that a first memory for storing credit account information and a second memory for storing starter credit account information are part of central database 1300 and not credit card issuer 1200. *See* Fig. 2.

We find that claim 30 does not set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). Therefore, we reject claim 30, and claims 31-36 under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 47-76, 107-111, and 119 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Taking claim 47 as representative, claim 47 recites “[a] computer-readable medium including instructions for performing a method.” We note that the Specification describes “a carrier wave from the Internet” as a computer-readable medium. Specification [0111]. Giving claim 47 the broadest reasonable construction, we find that claim 47 encompasses forms of the computer-readable medium being embodied on transitory propagation signals per se³. A signal does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

DECISION

The decision of the Examiner to reject claims 30-36, 47-58, 60-88, 90-116, 119, and 120 under 35 U.S.C. § 103(a) is reversed. We enter new grounds of rejection on claims 30-36, 47-76, 107-111, and 119.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

³ See *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....
- (2) *Request rehearing*. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record....

REVERSED; 37 CFR §41.50(b)

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